



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/730,606      | 12/08/2003  | Patrick J. Sweeney   | 029815-0105         | 4015             |

26371 7590 01/30/2007  
FOLEY & LARDNER LLP  
777 EAST WISCONSIN AVENUE  
MILWAUKEE, WI 53202-5306

|          |
|----------|
| EXAMINER |
|----------|

STEWART, ALVIN J

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3738

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 01/30/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/730,606 | <b>Applicant(s)</b><br>SWEENEY, PATRICK J. |  |
|                              | <b>Examiner</b><br>Alvin J. Stewart  | <b>Art Unit</b><br>3738                    |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/20/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-41 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 7, 9-17, 24-28, 30-32, 34 and 38-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al US Patent 5,858,020.

Johnson et al disclosed a body (16) having a central canal (18); extending there through; a head (24) coupled to the body; a first shaft (12) coupled to the body and extending through the central canal of the body. The shaft is capable of being interchanged after implantation of the prosthesis by removing the shaft and inserting a second shaft (112) without dislodging the body from the patient (lines 7-9 from the Applicant's claim discloses a wherein clause and have not been given patentable weight); wherein the shaft is coupled to the body via insertion of the shaft through an end of the central canal nearest an articular surface of the prosthesis (see Figures 1 and 4); wherein an insert (132, see Fig. 4) is coupled to the body and extending at least partially into the central canal (see Fig. 1).

Regarding claim 9, see Fig. 4.

Art Unit: 3738

Claims 1-3, 6-7, 11-14, 18, 24-28, 30, 33-34 and 36-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Muhlhausler et al US Patent 6,524,342 B1.

Muhlhausler et al disclosed a body (30) having a central canal (34); extending there through; a head (40) coupled to the body; a first shaft (10, see Fig. 2) coupled to the body and extending through the central canal of the body. The shaft is capable of being interchanged after implantation of the prosthesis by removing the shaft and inserting a second shaft (10, see Fig. 3) without dislodging the body from the patient (lines 7-9 from the Applicant's claim discloses a wherein clause and have not been given patentable weight); wherein the shaft is coupled to the body via insertion of the shaft through an end of the central canal nearest an articular surface of the prosthesis (see Figures 1-4); wherein an insert (20, see Fig. 3) is coupled to the body and extending at least partially into the central canal (see Fig. 1).

Regarding claim 36, see col. 4, lines 6-24.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 35 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al US Patent 5,858,020 in view of Huebner US Pub. 2003/0149486 A1.

Johnson et al discloses the invention substantially as claimed. However, Johnson et al does not disclose a second replacement shaft having a shaft longer than the first shaft.

Huebner teaches an implant having a plurality of shafts for the purpose of creating an implant that is sized properly between a possible mid-shaft fracture of the patient's bone (see paragraphs 35 and 36).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the shafts of the Johnson et al reference with the plurality of different shafts of the Huebner reference in order to create an implant that is sized properly between a possible mid-shaft fracture of the patient's bone.

Claims 4 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al US Patent 5,858,020 in view of Dong US Patent 5,282,865.

Johnson et al discloses the invention substantially as claimed. However, Johnson does not disclose a Morse taper lock.

Dong teaches an implant comprising a Morse taper lock connection between two structures for the purpose of locking the two structures together (see col. 3, lines 11-16).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Johnson et al connection with the Morse taper connection of the Dong reference in order to lock the two structure together.

***Allowable Subject Matter***

Claims 19-23 are allowed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J. Stewart whose telephone number is 571-272-4760. The examiner can normally be reached on Monday-Friday 7:00AM-5:30PM(1 Friday B-week off).

Art Unit: 3738

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*A. Stewart*  
**ALVIN J. STEWART**  
**PRIMARY EXAMINER**  
Art Unit 3738

December 11, 2006.